

FOR PTO-1083

FEB 24 2009

Mail Stop: AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Docket No.: 200.1133CON5
Date: February 20, 2009

In re application of: **Benjamin OSHLACK et al.**
Serial No.: 10/700,906
Filed: November 4, 2003
For: **TAMPER-RESISTANT ORAL OPIOID AGONIST FORMULATIONS**

Sir:

Transmitted herewith is an **Information Disclosure Statement under 37 CFR 1.56 (3 pages)** in the above-identified application.

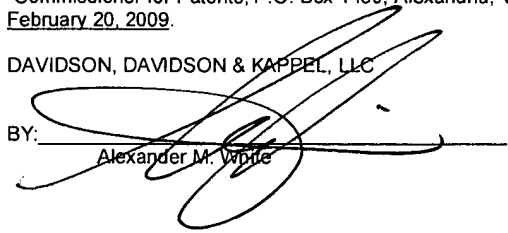
- ☒ Also transmitted herewith are:
- ☐ Petition for extension under 37 C.F.R. 1.136
 - ☒ Return receipt postcard
 - ☒ Other: Form PTO-1449 (1 page) with a copy of the document cited in the OTHER PRIOR ART section thereof; a copy of the Office Action issued on November 26, 2008 in U.S. Serial No. 10/700,861 (21 pages); a copy of the Office Action issued on November 25, 2008 in U.S. Serial No. 10/689,866 (18 pages); a copy of the Office Action issued on January 8, 2009 in U.S. Serial No. 10/701,041 (17 pages).
- ☒ Check(s) in the amount of \$ **180.00** is/are attached to cover:
- ☐ Filing fee for additional claims under 37 C.F.R. 1.16
 - ☐ Petition fee for extension under 37 C.F.R. 1.136
 - ☒ Fee set forth in 37 C.F.R. §1.17(p)
 - ☐ Other:
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0552.
- ☐ Any filing fee under 37 C.F.R. 1.16 for the presentation of additional claims which are not paid by check submitted herewith.
 - ☒ Any patent application processing fees under 37 C.F.R. 1.17.
 - ☒ Any petition fees for extension under 37 C.F.R. 1.136 which are not paid by check submitted herewith, and it is hereby requested that this be a petition for an automatic extension of time under 37 C.F.R. 1.136.


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I hereby certify that the documents referred to as attached therein and/or fee are being deposited with the United States Postal Service as "First Class Mail" with sufficient postage in an envelope addressed to Mail Stop: AMENDMENT, "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on February 20, 2009.

DAVIDSON, DAVIDSON & KAPPEL, LLC

BY: 
Alexander M. White



200.1133CON5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/700,906 Confirmation No.: 1129
Applicant : Benjamin OSHLACK et al.
Filed : November 4, 2003
Art Unit : 1615
Examiner : Humera N. SHEIKH
For : **TAMPER-RESISTANT ORAL OPIOID
AGONIST FORMULATIONS**
Attorney Docket No. : 200.1133CON5
Customer No. : 23280

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 20, 2009

INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.56

Sir:

In accordance with Applicants' duty of disclosure under 37 C.F.R. § 1.56 and the provisions of 37 C.F.R. §§ 1.97 and 1.98, Applicants hereby make of record the documents listed on the accompanying Form PTO-1449 (1 page).

Document AS is a copy of the COMPLAINT FOR DECLARATORY JUDGMENT ("Complaint") filed in the United States District Court for the Western District of Virginia by Alpharma Inc. on November 17, 2008, against Purdue Pharma L.P., the assignee of the present application. In COUNT XVIII of the Complaint, Alpharma Inc. alleges that each claim of U.S. Patent No. 6,696,088 "is invalid and/or unenforceable for failure to comply with the conditional requirements for patentability as set forth in Part II of Title 35 of the United States Code, including §§ 101, 102, 103, and

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112.” *See Complaint, page 21.* U.S. Patent No. 6,696,088 issued from U.S. Patent Application Serial No. 09/781,081, which has the identical specification as the present application¹.

Applicants note that all of the patents mentioned in the Complaint were cited on Forms PTO-1449 previously filed in connection with the present application. Regarding U.S. Patent No. 7,419,686, Applicants note that this patent was cited as U.S. Publication No. 2007-0122348 (reference BH on Form PTO-1449 filed on September 3, 2008).

In accordance with 37 C.F.R. § 1.98(a)(2), a copy of the Complaint is enclosed. If it is determined that the copy is missing, the Examiner is respectfully requested to contact the undersigned by telephone so that a duplicate copy may be forwarded.

Also enclosed herewith are copies of (i) the Office Action issued on November 26, 2008, in U.S. Serial No. 10/700,861, (ii) the Office Action issued on November 25, 2008, in U.S. Serial No. 10/689,866, and (iii) the Office Action issued on January 8, 2009, in U.S. Serial No. 10/701,041, all three applications having the identical specification and the priority claims as the present application.

It is respectfully requested that the information in these Office Actions and in the documents cited on the accompanying Form PTO-1449 (1 page) be considered in its entirety and made of record.

This Information Disclosure Statement is filed under 37 C.F.R. § 1.97(c), “before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application” and is accompanied by a check to cover the fee set forth in § 1.17(p). In the event any additional fee is due or an overpayment has been made in connection with the filing of

¹ The present application is a continuation of U.S. Patent Application Serial No. 09/781,081, filed on February 8, 2001, now U.S. Patent No. 6,696,088.

this Information Disclosure Statement, the Commissioner is hereby authorized to charge said fee or credit said overpayment to our Deposit Account No. 50-0552.

Respectfully submitted,
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By: 
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